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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/575,060	05/19/00	MAVUNKEL	B 21900-20290.

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HM22/0504

EXAMINER

CHANG, C

ART UNIT

PAPER NUMBER

1625

DATE MAILED:

05/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/575,060

Applicant(s)

MAVUNKEL ET AL.

Examiner

Celia Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 03 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims 1-44 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### DETAILED ACTION

1. Claims 1-44 are in the case.

2. *Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 10, 7-9, 13, drawn to Z1 is N, both l and k are one compounds, classified in class 544, subclass various depending on species election. If this group is elected, a further election of a single disclosed species is also required. Claims 1-6, 11-12, 15-41 reading on the elected compound can be prosecuted with the election to the extend of the elected compounds. One of the method of claims 42-44 can be prosecuted together with the elected compounds to the extend of the election upon election of a single disclosed pathology disclosed in claim 44.
- II. Claims 10 and 14, drawn to Z1 is CR5 both l and k are 1 compounds, classified in class 546, subclass various depending on species election. If this group is elected, a further election of a single disclosed species is also required. Claims 1-6, 11-12, 15-41 reading on the elected compound can be prosecuted with the election to the extend of the elected compounds. One of the method of claims 42-44 can be prosecuted together with the elected compounds to the extend of the election upon election of a single disclosed pathology disclosed in claim 44.
- III. Claims 1-6, 11-12, 15-41, remaining compounds where l and k and Z1 are not encompassed by the above two groups. If this group is elected, a further election of a single disclosed species is also required. Further restriction may be required. One of the method of claims 42-44 can be prosecuted together with the elected compounds to the extend of the election upon election of a single disclosed pathology disclosed in claim 44.
- IV. Claims 42-44, drawn to method of treating remaining pathology, classified in class 514, subclass various, depending on species election of active material and specific condition.

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The inventions are distinct, each from the other because of the following reasons:

The compounds of groups I, II and III are distinct and independent because the core structure is distinct and independent. Unpatentability of one group of compounds would not necessarily imply unpatentability of another because a reference anticipating one group of compounds would not render another group of compounds obvious.

The method of group IV is distinct and independent because each disease is an independent pathology with independent etiology and route of treatment. Ordinary skilled person in the art would not employ the same methodology in treating Alzheimer's disease and in treating asthma.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Should applicant traverse on the ground that the invention or the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. In the instant case, then there could have been no patentability of all the claims over Muro CA 88 see structure attached and R1 generically is alkyl i.e. isostere of A.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


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3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner can be reach by facsimile at (703) 308-7922 with courtesy voice message supra.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

CCPC/Chang  
May 2, 2001

  
CEILA CHANG  
PRIMARY EXAMINER  
GROUP 1200-165